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Cary Lee Bates

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IBM CORPORATION, INTELLECTUAL PROPERTY LAW
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EXAMINER

ELISCA, PIERRE E

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Please find below and/or attached an Office communication concerning this application or proceeding.

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/848,573
Filing Date: May 03, 2001
Appellant(s): BATES ET AL.

Gero G. McClellan
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 06/16/2008 appealing from the Office action mailed 12/12/2007.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The amendment after final rejection filed 02/12/2008 has been entered.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

5,159,560 Newell William C. et al 10/27/2007

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

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Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-7, 10, 13-15, 17, and 18 are rejected under 35 U.S.C. 102 (e) as being anticipated by Newell William C. et al (U.S. Pat. No. 5,159, 560).

As per claims 1-7, 10, 13-15, 17, and 18 Newell discloses a vending machine network which includes automatic inventory management, billing management and system maintenance. A system 100 includes a plurality of vending machine (e.g. vending machines 104-109) which are preferably adapted for renting articles such as videotapes, discs, cartridges, etc.,. Each vending machine (104-109) in the system 100 is capable of autonomous operation and includes means for receiving and dispensing articles, means for tracking which inventory items have been rented or are in stock, means for monitoring operational characteristics of the vending machine. Furthermore, the inventive concept of Newell also allows a number of vending machines, operating in diverse locations, to be used for dispensing and retrieving articles while allowing an article acquired from one vending machine to be returned to another in the system. Accordingly, it is inherent to recognize that the system of Newell is also capable of

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checking availability of one other vending machine (e.g. 104-109) see., Newell abstract, col 3, lines 42-67, col 4, lines 30-59, col 13- col 15. The inventive concept of Newell is readable as Applicant's claimed invention wherein said receiving, at a vending machine in the network of vending machines, a purchase order for the item, the vending machine being configured to dispense at least one type of item when stocked with the at least one item, the vending machine being configured to dispense at least one type of item when stocked with the at least one item, in response to receiving the purchase order, transmitting a request for the item via a network connection established through a network interface of the vending machine, and receiving, at the vending machine, a response to the request indicative of whether the item is available in at least one other vending machine configured to dispense the item when stocked with the item, whereby a user can retrieve the item at the at least one other vending machine when the item is available at the at least one other vending machine.

(10) Response to Argument

In regard to Applicant's arguments filed on 09/17/2007, Applicant continues to argue that the prior art of record Newell does not disclose:

a. "receiving, at the vending machine, a response to the request indicative of whether the item is available in at least one other vending machine configured to dispense the item when stocked with the item, whereby a user can retrieve the item at the at least one other vending machine when the item is available at the at least one other vending machine". However, the Examiner respectfully disagrees with Applicant's

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characterization of the prior art. As described above, Newell discloses a vending machine network which includes automatic inventory management, billing management and system maintenance. A system 100 includes a plurality of vending machine (e.g. vending machines 104-109) which are preferably adapted for renting articles such as videotapes, discs, cartridges, etc.,. Each vending machine (104-109) in the system 100 is capable of autonomous operation and includes means for receiving and dispensing articles, means for tracking which inventory items have been rented or are in stock, means for monitoring operational characteristics of the vending machine. Furthermore, the inventive concept of Newell also allows a number of vending machines, **operating in diverse locations**, to be used for dispensing and retrieving articles **while allowing an article acquired from one vending machine to be returned to another in the system (see., Newell, col 1, lines 40-53)**. Accordingly, it is inherent to recognize that the system of Newell is also capable of checking availability of one other vending machine (e.g. 104-109) see., Newell abstract, col 3, lines 42-67, col 4, lines 30-59, col 13- col 15.

b. Applicant further argues that Newell merely updates the location of the item in the networked inventory when an item is returned to a machine. Newell does not disclose the process of checking availability of one other vending machine. As noted above, it is the Examiner's principal position that Newell discloses an inventive concept of allowing an article acquired from one vending machine to be returned to another in the system (see., Newell, col 1, lines 40-53).

It is also the Examiner believes that since Newell allows an article to be returned to

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another in the system, and therefore capable of checking the availability of one other vending machine.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/ Pierre E. Elisca/
Primary Examiner, Art Unit 3621

Conferees:

/A. J. F./
Andrew J. Fischer
Supervisory Patent Examiner, Art Unit 3621

/EVENS J. AUGUSTIN/

Examiner, Art Unit 3621